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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/855,584
Filing Date: May 16, 2001
Appellant(s): COLLINS ET AL.

Samuel Borodach
(Registration # 38,388)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 29 April 2009 appealing from the Office action mailed 11 March 2008.

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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

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(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

U.S. 5,903,723	Beck et al.	05-1999
U.S. 6,052,735	Ulrich et al.	04-2000
U.S. 6,256,672	Redpath	07-2001
U.S. 6,311,210	Foladare et al.	10-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 6, 17, 23, 29, 40-42, 44-46, 48-50, 52-55, 57-60, 62-65 and 67-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foladare et al. (U.S. 6,311,210) in view of Redpath (U.S. 6,256,672) and further in view of Beck et al. (U.S. 5,903,723).

Claims 43, 47, 51, 56, 61, 66 and 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foladare in view of Redpath in view of Beck and further in view of Ulrich et al. (U.S. 6,052,735).

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 6, 17, 23, 29, 40-42, 44-46, 48-50, 52-55, 57-60, 62-65 and 67-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foladare et al. (U.S. 6,311,210) in view of Redpath (U.S. 6,256,672) and further in view of Beck et al. (U.S. 5,903,723).

Foladare teaches the invention substantially as claimed including when a sending party wishes to send an electronic mail message to a receiving party, the sending party creates the electronic mail message along with any attachments using his/her user device and sends the electronic mail message to the centralized electronic mail apparatus. The centralized electronic mail apparatus further determines the portions of the electronic mail message that are to be sent to each of the electronic mail receiving devices (see Abstract).

3. With respect to claim 6, teaches an article comprising a machine-readable medium storing machine-readable instructions that, when executed by the machine, cause the machine to perform the following operations: enable a sender to input a message; enable the sender to append an attachment to the message; enable the sender to designate at least one recipient of

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a plurality of recipients to receive the message and the attachment (Foldare, col. 3, lines 5-14); enable a recipient to create and edit a reception profile, the profile including the recipient's preferences with regard to receipt of prospective attachments (Foldare, col. 6, lines 8-17); and transmit the message over a network from the sender to the plurality of recipients, wherein (Foldare, col. 3, lines 5-14) the message is transmitted without the attachment to any recipient whose reception profile specifies not to receive an attachment, regardless of whether the sender designated the recipient to receive the message with or without the attachment (Foldare, col. 6, lines 21-40) and wherein if the sender designated the recipient to receive the message with the attachment, the message is transmitted from the sender with the attachment to any recipient whose reception profile specifies to receive an attachment (Foldare, col. 3, lines 5-54).

Foldare does not explicitly teach the sender designating a recipient to receive the message without the attachment.

However, Redpath teaches enabling the sender to designate at least one recipient of the plurality of recipients to receive the message without the attachment (Redpath, Fig. 3, element 230; col. 3, lines 19-31).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Foldare in view of Redpath in order to enable the sender designating a recipient to receive the message without the attachment. One would be motivated to do so in order to facilitate not wasting any storage space or download time sending redundant/unneeded materials.

The combination of Foldare and Redpath does not explicitly teach transmission of the message from the sender without the attachment.

However, Beck teaches the message is transmitted from the sender without the attachment (Beck, col. 5, lines 39-53).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Foldare and Redpath in view of Beck in order to enable transmission of the message from the sender without the attachment. One would be motivated to do so in order to more efficiently utilize processor and communications medium bandwidth and memory storage in a computer communications network.

4. With respect to claim 40, Foldare teaches the invention described in claim 6, including the article including instructions that, when executed by the machine, cause the machine to enable the recipient to create and edit a profile that specifies information about prospective attachments that the recipient is unable, or does not wish, to receive (Foldare, col. 6, lines 8-17 and lines 21-40).
5. With respect to claim 41, Foldare teaches the invention described in claim 40, including the article including instructions that, when executed by the machine, cause the machine to prevent recipient by the recipient of the prospective attachments that the recipient's profile indicates the recipient is unable, or does not wish, to receive (Foldare, col. 6, lines 8-17 and lines 21-40).

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6. With respect to claim 42, Foldare teaches the invention described in claim 41, including the article including instructions that, when executed by the machine, cause the machine to enable the recipient to create and edit a profile that specifies the recipient is not to receive attachments larger than a specified size (Foldare, col. 6, lines 8-17 and lines 21-40).

7. With respect to claim 52, Foladare teaches an article comprising a machine-readable medium storing machine-readable instructions that, when executed by the machine, cause the machine to perform the following operations: enable a sender to input a message; enable the sender to append an attachment to the message; enable the sender to designate at least one recipient of a plurality of recipients to receive the message and the attachment (Foladare, col. 3, lines 5-14); enable a recipient to create and edit a reception profile, the profile including the recipient's preferences with regard to receipt of prospective attachments (Foldare, col. 6, lines 8-17); and transmit the message over a network from the sender to the plurality of recipients, wherein (Foladare, col. 3, lines 5-14) the message is transmitted without the attachment to any recipient whose reception profile specifies not to receive an attachment, even though the sender designated that recipient to receive the message with the attachment (Foldare, col. 6, lines 21-40) and wherein if the sender designated the recipient to receive the message with the attachment, the message is transmitted from the sender with the attachment to any recipient whose reception profile specifies to receive an attachment (Foldare, col. 3, lines 5-54).

Foldare does not explicitly teach the sender designating a recipient to receive the message without the attachment.

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However, Redpath teaches enabling the sender to designate at least one recipient of the plurality of recipients to receive the message without the attachment (Redpath, Fig. 3, element 230; col. 3, lines 19-31).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Foldare in view of Redpath in order to enable the sender designating a recipient to receive the message without the attachment. One would be motivated to do so in order to facilitate not wasting any storage space or download time sending redundant/unneeded materials.

The combination of Foldare and Redpath does not explicitly teach transmission of the message from the sender without the attachment.

However, Beck teaches the message is transmitted from the sender without the attachment (Beck, col. 5, lines 39-53).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Foldare and Redpath in view of Beck in order to enable transmission of the message from the sender without the attachment. One would be motivated to do so in order to more efficiently utilize processor and communications medium bandwidth and memory storage in a computer communications network.

8. Claims 17, 23, 29, 44-46, 48-50, 53-55, 57-60, 62-65 and 67-70 do not teach or define any new limitations above claims 6, 40-42 and 52 and therefore are rejected for similar reasons.

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9. Claims 43, 47, 51, 56, 61, 66 and 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foldare in view of Redpath in view of Beck and further in view of Ulrich et al. (U.S. 6,052,735).

10. With respect to claim 43, Foldare teaches the invention described in claim 41, including an article comprising a machine-readable medium storing machine-readable instructions that, when executed by the machine, cause the machine to perform the following operations: enable a sender to input a message; enable the sender to append an attachment to the message; enable the sender to designate at least one recipient of a plurality of recipients to receive the message and the attachment (Foldare, col. 3, lines 5-14); enable a recipient to create and edit a reception profile, the profile including the recipient's preferences with regard to receipt of prospective attachments (Foldare, col. 6, lines 8-17); and transmit the message over a network from the sender to the plurality of recipients, wherein (Foldare, col. 3, lines 5-14) the message is transmitted without the attachment to any recipient whose reception profile specifies not to receive an attachment, regardless of whether the sender designated the recipient to receive the message with or without the attachment (Foldare, col. 6, lines 21-40) and wherein if the sender designated the recipient to receive the message with the attachment, the message is transmitted from the sender with the attachment to any recipient whose reception profile specifies to receive an attachment (Foldare, col. 3, lines 5-54).

Foldare does not explicitly teach the sender designating a recipient to receive the message without the attachment.

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However, Redpath teaches enabling the sender to designate at least one recipient of the plurality of recipients to receive the message without the attachment (Redpath, Fig. 3, element 230; col. 3, lines 19-31).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Foldare in view of Redpath in order to enable the sender designating a recipient to receive the message without the attachment. One would be motivated to do so in order to facilitate not wasting any storage space or download time sending redundant/unneeded materials.

The combination of Foldare and Redpath does not explicitly teach transmission of the message from the sender without the attachment.

However, Beck teaches the message is transmitted from the sender without the attachment (Beck, col. 5, lines 39-53).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Foldare and Redpath in view of Beck in order to enable transmission of the message from the sender without the attachment. One would be motivated to do so in order to more efficiently utilize processor and communications medium bandwidth and memory storage in a computer communications network.

The combination of Foldare, Redpath and Beck does not explicitly teach a profile that specifies that a recipient is not to receive attachments during a particular time.

However, Ulrich teaches the article including instructions that, when executed by the machine, cause the machine to enable the recipient to create and edit a profile that specifies

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the recipient is not to receive attachments during a particular time frame (Ulrich, col. 13, lines 12-16).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Foldare, Redpath and Beck in view of Ulrich in order to enable a profile that specifies that a recipient is not to receive attachments during a particular time. One would be motivated to do so in order to allow the user of a mobile device to dynamically retrieve individual electronic mail message attachments on a per message basis.

11. Claims 47, 51, 56, 61, 66 and 71 do not teach or define any new limitations above claim 43 and therefore are rejected for similar reasons.

(10) Response to Argument

The examiner summarizes the various points raised by the appellant and addresses them individually.

(A) Appellant Argues: The cited references do not disclose or suggest any control mechanism that provides for the recipient-side to affect processes at the sender side, such as whether an e-mail should be loaded onto a network at the sender-side with, or without, an attachment. The cited references disclose attachment-related processes that take place exclusively at the recipient-side (Foldare) or exclusively on the sender-side (Redpath Beck).

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That is, Foladare allows only for the recipient-side to control the recipient-side decisions, and Redpath and Beck allow only for the sender-side to control the sender-side decisions. However, according to claims 6, 17, 23, 29, 52, 57, 62 and 67, the reception profile, which is created and edited by a recipient on the recipient-side, impacts on or controls the transmission at the sender-side.

In Response: The examiner respectfully submits that there is nothing specific in the claim language that limits the independent claims to an interpretation of ‘a control mechanism that provides for the recipient-side to affect processes at the sender-side’. The way that the claim limitations are worded, particularly “transmit the message over a network from the sender to the plurality of recipients” followed by “wherein the message is transmitted from the sender without the attachment to any recipient whose reception profile specifies not to receive an attachment,” do not make it clear that the sender-side should be removing any attachments, and could be interpreted the way Appellant has characterized Foldare on page 8 in the Brief (“the centralized electronic mail device acts after the e-mail was previously sent by the user device, *i.e.*, transmitted from the user device to the centralized electronic mail device”).

The examiner respectfully submits that in this case, it has been shown that Foladare is directed to a centralized electronic mail device that determines which devices are to receive any attachments to the electronic mail message (see Foladare, col. 6, lines 20-23). In analogous art, Redpath is drawn to providing a visual indication of attachments without the necessity of including the attachment data in the mail (see Redpath, col. 1, lines 41-43). In additionally analogous art, Beck is shown to teach an attachment and e-mail message are created, but

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attachment is not transmitted to either post office or to [recipient] PCs. Rather, at this point attachment is stored in PC itself, and attachment reference is created to be transmitted as an attachment with e-mail primary message to recipient PCs. E-mail message and its attachment reference are transmitted to recipient PCs (see Beck, col. 5, lines 41-47).

The motivation to combine Foladare and Redpath was given in the rejection as “to facilitate not wasting any storage space or download time sending redundant/unneeded materials (Redpath, Abstract).” The motivation to combine Foladare, Redpath and Beck was given as “to more efficiently utilize processor and communications medium bandwidth and memory storage in a computer communications network (Beck, col. 1, lines 57-59).”

Moreover, the KSR decision supports the rationale that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention. Foladare was used as the primary reference, which is seen as disclosing all of the claimed subject matter except for that detailing the sender designating a recipient to receive the message without the attachment, and the transmission of the message from the sender without the attachment. However, designating a recipient to receive the message without the attachment limitation are covered by Redpath, and the message being transmitted from the sender without the attachment is covered by Beck. So all of the component parts of the claim are known in Foladare, Redpath and Beck. Thus, it would have been obvious to one having ordinary skill in the art to use the method of transmitting a message from the sender without the attachment taught by Beck and designating a recipient not to receive an attachment taught by Redpath with the electronic mail

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method discussed in the Foladare reference. These methods could be used in combination to achieve the predictable results of preserving bandwidth from being used to send attachments with an email.

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Foladare, Redpath and Beck.

Therefore, the combination Foldare, Redpath and Beck teaches enable a sender to input a message (the sending party may enter the electronic mail message); enable the sender to append an attachment to the message (the electronic mail message contains fields of information pertaining to attachments); enable the sender to designate at least one recipient of a plurality of recipients to receive the message and the attachment (the sending party may enter an electronic mail address of the receiving party – see Foladare, col. 3, lines 5-14); enable a recipient to create and edit a reception profile, the profile including the recipient's preferences with regard to receipt of prospective attachments (only those portions of the electronic mail message, which the receiving party deems the most important by identifying them in the profile database, are sent to the electronic mail receiving device. Thus, other information in the electronic mail message that the receiving party does not wish to see is not displayed– see Foldare, col. 6, lines 8-17); and transmit the message over a network from the sender to the plurality of recipients, and wherein (when a sending party wishes to send an electronic mail message to a receiving party, the sending party may enter the electronic mail message, which contains fields of information pertaining to the distribution list of the message – see Foladare, col. 3, lines 5-14) the message is transmitted without the attachment to any recipient whose reception profile specifies not to receive an attachment, regardless of whether the sender designated the recipient to receive the

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message with or without the attachment (the present invention may also determine which devices are to receive any attachments to the electronic mail message. A determination of whether or not to send attachments, which types of attachments to send and the like – see Foldare, col. 6, lines 21-40) and wherein if the sender designated the recipient to receive the message with the attachment, the message is transmitted from the sender with the attachment to any recipient whose reception profile specifies to receive an attachment (if one of the electronic mail receiving devices is a personal digital assistant (PDA) or personal computer, the entire electronic message may be sent to the PDA or personal computer – see Foldare, col. 3, lines 5-54).

Foldare does not explicitly teach the sender designating a recipient to receive the message without the attachment.

However, Redpath teaches enabling the sender to designate at least one recipient of the plurality of recipients to receive the message without the attachment (the present invention adds an “NC:” line. A copy of the e-mail document will be sent to the addressee in the “NC:” line without the underlying attachment data but with the attachment icon. Without actually including any underlying attached data – see Redpath, Fig. 3, element 230; col. 3, lines 19-31).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Foldare in view of Redpath in order to enable the sender designating a recipient to receive the message without the attachment. One would be motivated to do so in order to facilitate not wasting any storage space or download time sending redundant/unneeded materials.

The combination of Foldare and Redpath does not explicitly teach transmission of the message from the sender without the attachment.

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However, Beck teaches the message is transmitted from the sender without the attachment (if the user of a PC also wishes to attach an attachment, then this attachment and e-mail message are created, but attachment is not transmitted to either post office or to [recipient] PCs. Rather, at this point attachment is stored in PC itself, and attachment reference is created to be transmitted as an attachment with e-mail primary message to recipient PCs. E-mail message and its attachment reference are transmitted to recipient PCs – see Beck, col. 5, lines 39-53).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Foldare and Redpath in view of Beck in order to enable transmission of the message from the sender without the attachment. One would be motivated to do so in order to more efficiently utilize processor and communications medium bandwidth and memory storage in a computer communications network.

The claim language does not support the narrow interpretation Appellant describes in the Arguments, and therefore the combination of Foldare, Redpath and Beck anticipates the claimed invention by disclosing each and every limitation claimed.

(B) *Appellant Argues:* There is no connection between a scheduled synchronization (between desktop computer and mobile device) and a profile “that specifies the recipient is not to receive attachments during a particular time frame” as recited in claim 43. Thus, even though Ulrich discloses that the mobile device may not receive attachments, Ulrich does not disclose assigning specific time frames to this restriction.

In Response: The examiner respectfully submits that the combination of Foladare, Redpath, Beck and Ulrich teaches the article including instructions that, when executed by the machine, cause the machine to enable the recipient (user of a mobile device) to create and edit a profile (to either select a parameter in the user profile to automatically send all attachments, only some or none. If none are to be sent automatically, the user can select only those attachments which are desired. In a preferred embodiment, the commands include an add-file command which allows the user to add a file to be downloaded during the next synchronization – see Ulrich, col. 12, lines 33-37) that specifies the recipient is not to receive attachments during a particular time frame (attachment indicator field indicates the presence of an attachment to any electronic mail message displayed under the file name. Preferably, items displayed in attachment field indicate whether the attachment is scheduled to be downloaded at the next synchronization – see Ulrich, col. 13, lines 12-16).

Using a command within a profile to determine whether an attachment is scheduled to be downloaded is a way the user controls whether he or she receives attachments during a particular time frame, that time frame being the next time the mobile device is synchronized with the desktop computer. If the “none” option is chosen, then no attachments will be downloaded at the next sync, which is functionally equivalent to the recipient not receiving attachments during a particular time frame.

Thus, the combination of Foladare, Redpath, Beck and Ulrich anticipates the claimed invention by disclosing each and every limitation claimed.

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Alicia Baturay/

Examiner, Art Unit 2446

24 June 2009

/Jeffrey Pwu/

Supervisory Patent Examiner, Art Unit 2446

Conferees:

/Jeffrey Pwu/

Supervisory Patent Examiner, Art Unit 2446

/John Follansbee/

Supervisory Patent Examiner, Art Unit 2451